UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,859	11/12/2003	James McLennan	1530	6702

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ART UNIT	PAPER NUMBER
2466	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/706,859	MCLENNAN ET AL.
	Examiner	Art Unit	
	JAE Y. LEE	2466	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 August 2009*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *30-58* is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *30-58* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
  1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. _____.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date *12 August 2009*.

4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Priority

1.   Acknowledgment is made of applicant's claim for foreign priority based on an
application filed in United Kingdom on 09 October 2003 and 19 October 2003. It is
noted, however, that applicant has not filed a certified copy of the 0323625.4 and
0323626.2 applications as required by 35 U.S.C. 119(b).

Response to Amendment

2.   Rejections of claims 1-13 and 28, and 29 under 35 USC § 101 have withdrawn
due to the canceled claims.

3.   Examiner considered the method claim 30 to determine that the claim was
statutory under 35 USC § 101. The present claim discloses *"storing data ... examining
stored data ... extracting stored data ... generating a communication with the stored
data ... rendering a response template containing data definition and conditional criteria,
and applying the criteria to the data definition and to the stored data whereby to
compose the communication ... the conditional criterion in the response template
automatically activates alternative selections of text and data."* Since the conditional
criterion in the response template ***automatically*** activates alternative selection, the
present claim is implicitly implemented by a particular machine. Moreover, the particular
machine imposes a meaningful limit on the claim's scope because the particular
machine is not merely used for field-of use limitation, e.g., storing data to generate
communication, rather, it generates communication by activating automatically

alternative selection based on the response template containing data definition and

conditional criteria. Therefore, the present method claim is **_eligible_** statutory process.

4.   Claims 1-29 have been cancelled.

5.   Claims 30-58 have been added.

Response to Arguments

6.   Applicant's arguments with respect to claims 1-58 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.   **Claims 31-36, 42-52, and 58** are rejected under 35 U.S.C. 102(b) as being

anticipated by Powers (US 6,438,584).

For claims 30, 46, Powers discloses a method and a system comprising:

- storing data relating to the recipient in a data store (Fig. 1, 2; col 15 lines 34-43: a

    sender must first register obtaining information from the sender for the database

and a registered sender provides address information for each recipient and the
nature of the conveyance (e.g., fax, postal mail or express courier));

- examining the stored data to determine if a communication is to be provided to
  the recipient (Fig 1, 2; col 3 lines 54-57: obtaining recipient location formation
  from data base containing names and addresses);

- if a communication is to be provided to the recipient, extracting stored data
  relating to the recipient from the data store (Fig 1, 2; col 7 lines 40-46:
  determining the addressing and delivery information for the intended recipient;
  col 7 lines 46-49: final composition process for fax delivered correspondence
  items, print delivered correspondence items);

- generating a communication with the stored data (col 6 lines 36-53: composition
  module retrieves various components or preferences from the database entries
  stored for a particular sender to create the image of the letter it is producing and
  delivery means, such as HTML, emailFax, and printed hardcopy all have different
  requirements of resolution and color, so the database must store a different
  image for each type or output; col 7 lines 46-49: final composition process for fax
  delivered correspondence items, print delivered correspondence items); and

- sending the message to the recipient (col 3 lines 40-45: generating completed
  mail objects from email message from registered senders to be received by
  recipients in hard copy);

- wherein the step of generating a communication (col 6 lines 36-53: composition
  module retrieves various components or preferences from the database entries

stored for a particular sender to create the image of the letter it is producing and delivery means, such as HTML, emailFax, and printed hardcopy all have different requirements of resolution and color, so the database must store a different image for each type or output; col 7 lines 46-49: final composition process for fax delivered correspondence items, print delivered correspondence items) comprises the steps of:

- reading a response template which contains data definitions and conditional criteria (col 8 lines 54-56: fax cover sheet is composed according to sender database entries and an HTML document template supplied by the system and precedes the letter; col 9 lines 24-30: the appropriate HTML template is selected and the templates are part of the system and provide an "HTML" shell that can be modified to various sender specific graphics and contents into the correspondence item);

- applying said criteria to the data definitions and to the stored data whereby to compose the communication by selecting text and data in response to the criteria (col 8 lines 54-56: fax cover sheet is composed according to sender database entries and an HTML document template supplied by the system and precedes the letter; col 9 lines 24-30: the appropriate HTML template is selected and the templates are part of the system and provide an "HTML" shell that can be modified to various sender specific graphics and contents into the correspondence item; col 9 lines 31-34: appropriate screen resolution graphics

are retrieved from database and references inserted into the HTML template);

and

- wherein the conditional criterion in the response template automatically activates

  alternative selections of text and data according to whether the criterion is met or

  whether the criterion is not met (col 7 lines 55-57: automatic composition

  activities for the sender; col 7 58-67: determining the type of correspondence,

  determining delivery methods, determining the format and size and layout of a

  correspondence item; col 9 lines 28-29: generating the entire HTML

  programmatically; col 9 lines 31-34: retrieving appropriate screen resolution

  graphics from database and inserting into the HTML template; col 9 lines 35-37:

  the fonts are determined from the sender's database and references are inserted

  into the HTML template)

For claims 31, 47, Powers discloses

- wherein the data definitions point to one of data in the stored data and alternative

  fixed text items within the response template, and said one of data and

  alternative fixed text items within the response template so pointed to is included

  in the selected text and data (col 9 lines 24-30: the appropriate HTML template is

  selected and the templates are part of the system and provide an "HTML" shell

  that can be modified to various sender specific graphics and contents into the

  correspondence item; col 9 lines 35-37: the fonts are determined from the

sender's database and references are inserted into the HTML template; col 9

lines 38-39: data of the letter is composed and inserted into the HTML template)

For claims 32, 42, 48, 58, Powers discloses

- selecting, in response to the stored data, at least one medium from among a

  plurality of selectable media for providing the communication to the individual (col

  6 lines 36-53: composition module retrieves various components or preferences

  from the database entries stored for a particular sender to create the image of

  the letter it is producing and delivery means, such as HTML, emailFax, and

  printed hardcopy all have different requirements of resolution and color, so the

  database must store a different image for each type or output; col 7 lines 46-49:

  hardcopy printed letter automatic composition);

- composing the communication in a form suitable for use on said at least one

  selected medium (col 7 lines 55-57: automatic composition activities for the

  sender; col 7 58-67: determining the type of correspondence, determining

  delivery methods, determining the format and size and layout of a

  correspondence item); and

- employing said at least one selected medium to send the communication (col 8

  lines 48-50: if express/registered/certified delivery is indicated, the necessary

  FedEx or UPS or US Postal forms are composed and sent with the print job)

For claims 33, 43, 49, Powers discloses

- wherein the step of composing the communication in a form suitable for use on a selected medium includes the step of applying a conditional criterion in the response template to the stored data in order to determine the medium (col 6 lines 36-53: composition module retrieves various components or preferences from the database entries stored for a particular sender to create the image of the letter it is producing and delivery means, such as HTML, emailFax, and printed hardcopy all have different requirements of resolution and color, so the database must store a different image for each type or output; col 7 lines 46-49: hardcopy printed letter automatic composition; col 7 lines 62-65: the delivery method(s) of correspondence (e.g., Email/FAX/Postal/Express) is determined from the sender's addressee database entry(ies) for each recipient(s); col 7 lines 46-49: final composition process for fax delivered correspondence items, print delivered correspondence items)

For claims 34, 44, 50, Powers discloses

- wherein the response template includes a layout template which is used according to the selected medium (col 6 lines 36-53: composition module retrieves various components or preferences from the database entries stored for a particular sender to create the image of the letter it is producing and delivery means, such as HTML, emailFax, and printed hardcopy all have different requirements of resolution and color, so the database must store a different image for each type or output; col 7 lines 46-49: hardcopy printed letter automatic

composition; col 7 line 66-col 8 line 2: layout of a correspondence item is

determined)

For claims 35, 45, 51, Powers discloses

- wherein the layout template defines at least one place holder for content for the

  specific corresponding medium (col 7 lines 46-49: hardcopy printed letter

  automatic composition; col 8 lines 24-27: body of the correspondence specified

  by sender request is formatted and composed according to the retrieved fonts

  and layout; col 8 lines 54-56: fax cover sheet is composed according to sender

  database entries and an HTML document template supplied by the system and

  precedes the letter)

For claims 36, 52, Powers discloses

- wherein said step of storing data relating to the recipient includes the step of

  accepting data from at least one of: the Internet; a digital data transmission

  medium; telephonic text messages; telephonic voice messages; printed matter;

  other data files; and record data files (col 6 lines 42-49: addresses of postal,

  street for FedEx, Internet, and facsimile; col 7 lines 62-65: determining delivery

  method of the correspondence including Email/FAX/Postal/Express from the

  sender's addressee database entry for each recipient)

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
        obviousness or nonobviousness.

11.   **Claims 37-41 and 53-57** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Powers (US 6,438,584)

        For claims 37, 53, Powers discloses

- wherein the conditional criteria in the response template include a criterion (col 8

    lines 54-56: fax cover sheet is composed according to sender database entries

    and an HTML document template supplied by the system and precedes the

    letter; col 9 lines 24-30: the appropriate HTML template is selected and the

    templates are part of the system and provide an "HTML" shell that can be

    modified to various sender specific graphics and contents into the

    correspondence item)

Powers does not explicitly disclose determining the language of the

communication, and the communication is composed accordingly in a selectable one of

a plurality of languages, the particular one of the plurality of languages being selected in

response to the extracted stored data relating to the recipient. However, Powers

discloses obtaining recipient location formation from data base containing names and

addresses (Fig 1, 2; col 3 lines 54-57), appropriate HTML template is selected and

modified to insert various sender specific graphics and contents into the

correspondence item (col 9 lines 24-30), and hard copy delivery via London ENGLAND,

Frankfurt GERMANY for Europe and Hong Kong CHINA for Asia (col 15 lines 26-31).

Therefore, it would have been obvious to the person of ordinary skill in the art at the

time of invention was made to select language corresponding to the address and

country in order to deliver the messages in flexible manner.

For claims 38, 54, Powers discloses

- including the step of using at least one element of the address of the recipient

    (Fig 1, 2; col 3 lines 54-57: obtaining recipient location formation from data base

    containing names and addresses) to determine the selected language, said at

    least one element being selected from at least one of: the country of the

    recipient; the state of the recipient; the region of the recipient; the city of the

    recipient; the postal code of the recipient; and the family name of the recipient

    Powers does not explicitly disclose to determine the selected language, said at

least one element being selected from at least one of: the country of the recipient; the

state of the recipient; the region of the recipient; the city of the recipient; the postal code

of the recipient; and the family name of the recipient. However, Powers discloses

obtaining recipient location formation from data base containing names and addresses

(Fig 1, 2; col 3 lines 54-57), appropriate HTML template is selected and modified to

insert various sender specific graphics and contents into the correspondence item (col 9

lines 24-30), and hard copy delivery via London ENGLAND, Frankfurt GERMANY for

Europe and Hong Kong CHINA for Asia (col 15 lines 26-31). Therefore, it would have

been obvious to the person of ordinary skill in the art at the time of invention was made

to select language corresponding to the address and country in order to deliver the

messages in flexible manner.

For claim 39, 55, Powers discloses

- wherein the conditional criteria in the response template include a criterion (col 8

   lines 54-56: fax cover sheet is composed according to sender database entries

   and an HTML document template supplied by the system and precedes the

   letter; col 9 lines 24-30: the appropriate HTML template is selected and the

   templates are part of the system and provide an "HTML" shell that can be

   modified to various sender specific graphics and contents into the

   correspondence item) for determining the idiom of the communication, and the

   communication is composed accordingly in one of a plurality of idioms, the

   particular idiom being selected in response to the extracted stored data relating

   to the recipient (col 6 lines 36-53: composition module retrieving letter closing

(e.g., sincerely, best regards, right on!, etc.) and greeting (e.g., Mr. or Ms, full
name of recipient or first name of recipient) from database entries; col 7 lines 46-
49: final composition process for fax delivered correspondence items, print
delivered correspondence items)

For claims 40, 56, Powers discloses

- wherein the conditional criteria in the response template include a criterion (col 8
  lines 54-56: fax cover sheet is composed according to sender database entries
  and an HTML document template supplied by the system and precedes the
  letter; col 9 lines 24-30: the appropriate HTML template is selected and the
  templates are part of the system and provide an "HTML" shell that can be
  modified to various sender specific graphics and contents into the
  correspondence item)

Powers does not explicitly disclose for determining a form of the communication
suitable for use in a selectable one of a plurality of jurisdictions, the particular one of the
plurality of jurisdictions being selected in response to the extracted stored data relating
to the recipient. However, Powers discloses written communication formats including
business legal notifications (col 1 lines 40-47), type of correspondence including Legal
is determined from approved proof copy form (col 7 lines 46-49), appropriate HTML
template is selected and modified to insert various sender specific graphics and
contents into the correspondence item (col 9 lines 24-30), and resolution quality for
legal documents (col 13 lines 35-40). Therefore, it would have been obvious to the

person of ordinary skill in the art at the time of invention was made to select proper legal

document template from approved proof copy form among plurality of formats in flexible

manner.

       For claim 41, 57, Powers discloses

- including the step of using at least one element of the address of the recipient

  (Fig 1, 2; col 1 lines 40-47: written communication formats including business

  legal notifications; col 3 lines 54-57: obtaining recipient location formation from

  data base containing names and addresses; col 7 lines 46-49: final composition

  process for fax delivered correspondence items, print delivered correspondence

  items; col 7 lines 58-61: type of correspondence including Legal is determined

  from approved proof copy form; col 13 lines 35-40: resolution quality for legal

  documents)

Powers does not explicitly disclose to determine the selected jurisdiction, said at

least one element being selected from at least one of: the country of the recipient; the

state of the recipient; the region of the recipient; the city of the recipient; and the postal

code of the recipient. However, Powers discloses written communication formats

including business legal notifications (col 1 lines 40-47), type of correspondence

including Legal is determined from approved proof copy form (col 7 lines 46-49), postal

address (col 4 lines 18-20), resolution quality for legal documents (col 13 lines 35-40),

obtaining recipient location formation from data base containing names and addresses

(Fig 1, 2; col 3 lines 54-57), appropriate HTML template is selected and modified to

insert various sender specific graphics and contents into the correspondence item (col 9 lines 24-30), and hard copy delivery via London ENGLAND, Frankfurt GERMANY for Europe and Hong Kong CHINA for Asia (col 15 lines 26-31). Therefore, it would have been obvious to the person of ordinary skill in the art at the time of invention was made to select proper legal document corresponding to the address and country in flexible manner.

Conclusion

12.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jae Y. Lee whose telephone number is (571) 270-3936. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Ryman can be reached on (571) 272-3152. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jae Y Lee/   /Daniel J. Ryman/
Examiner, Art Unit 2466   Supervisory Patent Examiner, Art
                                                         Unit 2466